

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 08551-00xx  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 3013892	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.83(a)]  on <u>December 16, 2005</u> Signature <u>Amanda Cogar</u>  Typed or printed name <u>Amanda Cogar</u>		Application Number 10/029,928	Filed 12/31/2001
		First Named Inventor Doherty, James M.	
		Art Unit 2152	Examiner Lesniewski, Victor D.
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the  <input type="checkbox"/> applicant/inventor.  <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)  <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>53832</u>  <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____		<u>Ramraj Soundararajan</u> Signature  <u>Ramraj Soundararajan</u> Typed or printed name  <u>(703) 838-7683</u> Telephone number  <u>12-16-2005</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

BEST AVAILABLE COPY

T00362  
10/029,928

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**RECEIVED  
CENTRAL FAX CENTER**

DEC 16 2005

In re Application of: James M. Doherty

Serial No.: 10/029,928

Group Art Unit: 2152

Filed: 12/31/2001

Examiner: Victor Lesniewski

Title: *Residential Gateway System for Automated Control of Residential Devices*REASONS TO SUPPORT PRE-APPEAL BRIEF REQUEST FOR REVIEWCommissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This pre-appeal brief request is in response to the Examiner's Office Action dated 09/21/2005. Reconsideration of this application is respectfully requested in view of the remarks that follow.

Claims 1, 2, 8, 10, 11, 17, 18, 20, 21, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Petite (USP 6,437,692) in view Fukunaga (USP 6,144,993). To establish a prima facie case of obviousness under U.S.C. § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Additionally, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure (In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Page 1 of 4

**BEST AVAILABLE COPY**

**BEST AVAILABLE COPY**T00362  
10/029,928

One feature of applicant's pending independent claims 1, 10 and 20 recites the determination of control parameters from both the control information accessed from one or more information servers and state information of the residential device. The examiner cites column 7, lines 54-57 as teaching the limitations of determining control parameters from relevant control information accessed from one or more information servers on the Internet, as per applicant's pending independent claims 1, 10 and 20. With respect to independent claims 1, 10 and 20, the examiner appears to equate server 260 of the Petite reference to applicant's "control server". Similarly, the examiner appears to equate database 270 disclosed in column 7, lines 54-57 of the Petite reference to applicant's limitation of one or more information servers.

Applicant respectfully submits that column 7, lines 54-57 merely discloses that "database 270 and server 260 may act as data collection and reporting devices". As stated in column 7 of the Petite reference, server 260 merely collects, formats, and stores client specific data from multiple transceivers. An explicit or implicit recitation of a control server that determines control parameters from one or more information servers is absent in column 7, lines 54-57 of the Petite reference or the Petite reference in its entirety.

Applicant contends that Petite's database 270 is just a conventional database for storing data and cannot be equated to applicant's information servers storing "control information" that is accessible over the Internet. Column 6, lines 29-30 support applicant's argument that element 270 is a conventional database, as it states that the database is used to record client specific data – with no mention of control information being stored. Applicant also contend that it would be incorrect to argue that Petite's server 260 could work in conjunction with database 270 to determine "control parameters" as the database merely stored client specific data.

Page 2 of 4

**BEST AVAILABLE COPY**

T00362  
10/029,928

Applicant agrees with the examiner's statement that the Petite reference fails to teach the limitation of determining control parameters from state information of a residential device. Applicant, however, respectfully disagrees that such a limitation is rendered obvious by the combination of the Petite and Fukunaga references. Specifically, the examiner appears to rely on the Fukunaga reference for teaching the determination of control parameters from state information of the residential device. However, applicant respectfully submits that the Fukunaga reference merely teaches returning the state of "input elements" such as "a sensor, a switch, and the like" and not state information of a "residential device" connected to a "residential gateway".

Specifically, column 4, lines 47-64 of the Fukunaga reference merely states returning state information from input elements such as sensors connected to various terminals in a building automation system. Conspicuously absent from the citations is a control server that determines control parameters to control a residential device based on state information of the residential device.

As mentioned earlier, the Petite reference fails to teach or suggest the determination of control parameters from the control information accessed from one or more information servers. Even, if assumed, arguendo, that such a limitation is taught for in the Petite reference, applicants submit that there is no motivation in the Petite reference for modifying server 260 to incorporate the teachings of Fukunaga such that server 260 is able to determine control parameters from both the control information accessed from one or more information servers and state information of the residential device. Hence, applicant respectfully contends that the required prima facie case of obviousness has not been established.

Page 3 of 4

T00362  
10/029,928


In addition to the failure of the examiner to establish a prima facie case of obviousness, as detailed above, applicant respectfully submits that an improper §103 rejection was issued as the cited references fail to teach or suggest many of the claimed limitations.

Hence, the applicant contends that the independent claims 1, 10, and 20 are not anticipated or rendered obvious by the Petite reference in view of the Fukunaga reference. Applicant, therefore, submits that claims 1, 10, and 20 are allowable. Further, applicant respectfully requests reconsideration of dependent claims 2-4, 6-9, 11-13, 15-19, 21-23, and 25-28 as they depend from an allowable claim.

This request has been timely filed within the set period of response, no petition for extension of time or associated fee is required. However, the Commissioner is hereby authorized to charge any deficiencies in the fees provided to Deposit Account No. 12-0010.

If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact applicant's representative at the below number.

Respectfully submitted,

  
Ramraj Soundararajan  
Registration No. 53,832

1725 Duke Street  
Suite 650  
Alexandria, Virginia 22314  
(703) 838-7683  
December 16, 2005

Page 4 of 4

BEST AVAILABLE COPY